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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,160

02/12/2004

Daniel C. Perry

2159

34938

7590

12/08/2005

ADS SPECIALISTS, INC
2657 WINDMILL PKWY #168
HENDERSON, NV 89074

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT PAPER NUMBER

2635

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,160

Applicant(s)

PERRY, DANIEL C.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

EXAMINER'S RESPONSE

1. In response to the application filed 2-12-04, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

The oath by Daniel C Perry includes a signature of "/gledwards/" corresponding to agent Gary Edwards that appears to be improper because the signature must be provided by the inventor. Further, the application includes a transmittal letter identifying a Gary Edwards as an agent that is improper because there is no power of attorney by the inventor that

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identifies the agent, the agent's registration number is not identified, and the electronic signature "/gledwards" lacks the required second forward slash. Therefore, the application is considered to be pro-se.

3. A new oath or declaration is required because of the reasons stated above. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the receiver, decoder, action signaling means, transmitting system and transmitter connected to the receiver must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior

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version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The misnumbered claims have been renumbered as claims 1-5.
See the attached marked-up copy of the claims.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks any detailed description of the receiver, decoder, action signaling means, transmitting system and transmitter connected to the receiver of claims 1-5. The "other signaling means" in the summary is not sufficient structure to enable one to make and/or use the claimed signaling means.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is unclear because the preamble identifies a "method," but body of the claim specifies apparatus limitations rather than method steps. Further, the interpretation of the "signaling means" as disclosed structure under 35 USC 112 paragraph 6 is unclear because no particular structure is identified.

Claim Rejections - 35 USC § 102 & 103

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as

being anticipated by Morita (US 4814742). Regarding claim 1, Morita discloses a method (flow charts in figs. 9-12) to identify storage containers (boxes 2) that require some action to be executed (picking, locating, etc.) wherein the containers may have been stored or held in some location that is not required to be known to any information system (boxes are in cabinets or shelves without any predetermined location specified), the said storage containers having a receiver (58,59) capable of detecting a communication signal that is delivered to an associated decoder (57) that uniquely identifies each individual container, the decoder capable of activating a action signaling means (65/73, 66/45) on the individual container, and a transmitting system (5/11) generating said communication signal to direct an action. See figs. 1-3, 7, and col. 2 line 38 - col. 3 line 10, col. 4 line 43 col. 4 line 17, col. 4 lines 24-39 and col. 5 lines 37-68. Regarding claim 3, the transmitter and receiver communication signal uses a light (optical) for receiver activation in col. 2 line 47-53, col. 2 line 67 - col. 3 line 2 and col. 4 lines 24-28 of Morita. Regarding claim 4, the receiver decoder id is additionally connected to a transmitter (60,61,62) and the purpose of the transmitter is to provide a signal (answer back) which will allow the location of the container in col. 3 lines 40-50, col.

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4 lines 26-28 and col. 5 lines 37-56 of Morita. Regarding claim 5, the receiver decoder id is additionally connected to a transmitter (60,61,62) and the purpose of the transmitter is to provide an action acknowledgement signal in col. 3 lines 40-50, col. 4 lines 26-28 and col. 5 lines 37-56 Morita.

13. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 4814742) as applied above in view of Cannon (US 5689238). Regarding claim 2, Morita does not expressly disclose radio communication between the transmitter and receiver, but col. 5 lines 66-68 of Morita states that the communication is not limited to optical, but ultrasonic or magnetic wave for example is also available. Further col. 7 lines 62-65 of Morita states that the relay units 113 are not limited to hardwiring, optical or radio wave communication for example is also available. Cannon discloses an analogous art container (file) locator using inductive or radio (RF) signals for communication between an interrogator/reader and a tag in col. 1 line 43, col. 2 line 47, col. 3 line 3 and col. 5 line 14 that allows location by signal strength measurement and passive backscatter response. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the radio communication of Cannon in the method of

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Morita in order to allow location by signal strength measurement and passive backscatter response and is suggested by Morita teaching the communication is not limited to optical, as magnetic or radio wave for example is also available. Regarding claim 4, if location by the answerback response of Morita is not clear, then location by the response signal would have been obvious in view of Cannon disclosing this to allow location by indication of a proximity or distance to the container/tag derived by a signal strength measurement communicated as a passive backscatter response.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lander, (US 4476469), Caswell (US 46365950), Nakamura (US 5006996), Woolley (US 5774876) and Engellenner (US 5786764) disclose package or object locators.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The

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Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
12/6/05


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635